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IN THE
Supreme Court of the United States

OCTOBER TERM, 1942.

No. **243**

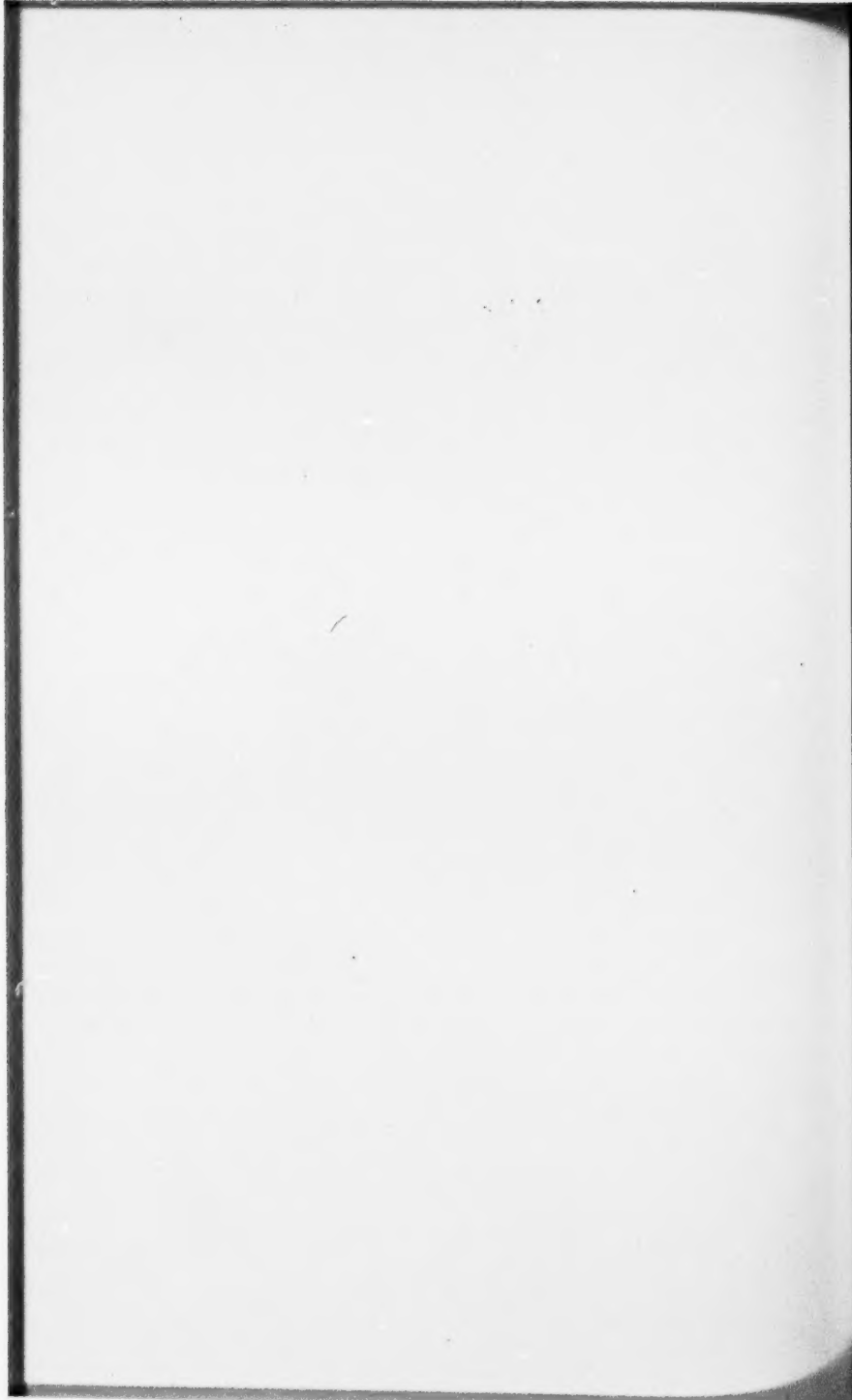
GENERAL RADIO COMPANY,
Petitioner,

vs.

ALLEN B. DU MONT LABORATORIES, INC.,
Respondent.

**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE THIRD CIRCUIT AND BRIEF IN SUP-
PORT THEREOF**

DEAN S. EDMONDS,
R. MORTON ADAMS,
BALDWIN GUILD,
GEORGE E. FAITHFULL,
W. PETERS BLANC,
Counsel for Petitioner.



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IN THE
Supreme Court of the United States

OCTOBER TERM, 1942

GENERAL RADIO COMPANY,

Petitioner,

vs.

ALLEN B. DuMONT LABORATORIES, INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI

*To the Honorable, the Chief Justice and the Associate
Justices of the Supreme Court of the United States:*

Your petitioner, General Radio Company, prays that a writ of certiorari issue to review the decree of the United States Circuit Court of Appeals for the Third Circuit, entered herein on May 12, 1942 (R. 311). Rehearing and reconsideration by that Court were requested and were denied June 3, 1942, and June 12, 1942, respectively (R. 325 and 332).

A certified transcript of the record in the case, including the proceedings in the Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of this Court.

Summary Statement of the Matter Involved

This is a suit in equity brought by petitioner against respondent in the United States District Court for the District of Delaware for infringement of claims 4, 6, 7, 8, 9,

10, 11, 12 and 13 of Bedell reissue patent No. 20,945 granted December 13, 1938 on application filed August 18, 1937. The reissue patent is founded upon original patent No. 1,707,594, for a "Device for Indicating Oscillograph Curves as Stationary" granted April 2, 1929, on an application filed May 7, 1927. Copies of the original and reissue patents may be found at pages 71 and 63 of the record. The District Court held the claims in suit of the reissue patent valid and infringed (R. 127, 138). The Court of Appeals, without consideration of the merits of the invention, reversed the decision of the District Court, holding the reissue invalid on the ground that the error of the original patent sought to be corrected by the reissue did not arise by any "inadvertence, accident or mistake" contemplated by the Reissue Statute and on the additional ground that there had been unreasonable delay in discovering the error and applying for reissue* (R. 315).

The invention relates to a device known as a cathode-ray oscillograph, the purpose of which is to analyze the characteristics of an electric current flowing in a circuit and to indicate these characteristics in the form of a curve projected upon a fluorescent screen. Prior to the invention the existing cathode-ray oscillograph comprised a cathode-ray tube which projected a beam of electrons upon a fluorescent screen and two sets of deflecting plates positioned around this beam, one set of plates being actuated by the incoming current under examination and the other by an independent current in an oscillator circuit which was synchronized as closely as possible to the frequency of the incoming current. These plates deflected the electron beam both vertically and horizontally thereby causing it to trace upon the fluorescent screen a curve representing the characteristics of the current under examination. The device, however, was unable to maintain the curve

*The full text of the Reissue Statute, R. S. 4916, will be found in the Appendix, pages 31-2.

upon the screen in a stationary position due to the impossibility of maintaining the oscillator in synchronism with the frequency of the incoming current. Consequently, in order to read the curve accurately, constant manual readjustment of the oscillator was required.

Bedell discovered that the introduction of a small voltage from the electric current under examination into the oscillator circuit would lock the oscillator into absolute synchronization with the frequency of the current under examination and that the curve traced upon the screen would consequently remain stationary without manual adjustment. Bedell accomplished this by an appropriate coupling. The introduction of this additional element into the old combination created a new combination of elements consisting of a cathode-ray tube, deflecting plates, and a coupling between the conductor of the current under examination and the oscillator circuit. It has not been questioned in this case that the invention is for a true combination. Each of the elements is so related to the others and so cooperates with them that together they produce a new result impossible of attainment in the absence of that relationship.* Consequently, Bedell was entitled to claims covering the new combination as such and having a scope which could not be evaded by the mere substitution of equivalents.

Claims 1 to 6 of the original patent were accordingly directed to the combination. Claim 1, which is typical, reads as follows:

“In a device of the type described, a cathode-ray tube, two sets of deflecting elements fixed in position with respect to said tube and with respect to each other

*Electric Cable Joint Co. v. Brooklyn Edison Co., Inc., 292 U. S. 69, 79; Leeds & Catlin v. Victor Talking Machine Co., 213 U. S. 301, 318; Gill v. Wells, 22 Wall. 1, 26; Robinson on Patents, Vol. II, Sec. 528.

for deflecting the cathode beam periodically, and means for indicating the curve formed by the deflected beam as stationary."

It has long been the established practice, approved by the Patent Office, to claim a combination by defining the elements of the combination by the terms "means" followed by the statement of the function performed by the means in the combination.* This is apparently what the solicitor was attempting to do in drafting claims 1 to 6 of the original patent and the Patent Office apparently thought he had succeeded in doing so since it allowed the claims.

Although the Court of Appeals held claims 1-6 invalid as a matter of law because of their form, there is nothing in the facts of the case to indicate that the patentee, petitioner or anyone else ever doubted that the claims were not in proper form until present counsel so advised petitioner in 1937. The pertinent facts follow: The application was prepared by Munn & Co. (R. 72), now and for many years nationally known patent attorneys of good reputation. There is no suggestion that the prosecution of the application for the original patent was other than routine. As stated the Patent Office granted the patent and thus placed its seal of approval on the form

*The rule of the Patent Office was distinctly stated as early as 1904 in *Young v. Eick*, 113 O. G. 547, 1904 C. D. 465: "The use of the word 'means' limited by a statement of function has long been recognized as the proper method of stating an element of a combination claim." See also *Ex parte Walker*, *Mizer & Dearsley*, 21 U. S. P. Q. 51, 1928; *Ex parte Dearsley*, 21 U. S. P. Q. 54, 1928; *Ex parte Louis N. D. Williams*, 2 U. S. P. Q. 93, 1929. The same rule was applied in the Federal Courts, *Morley Sewing Machine Co. v. Lancaster*, 129 U. S. 263, 286; *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, 422; *Arnold v. Tyden*, 193 Fed. 410, C. C. A. 7, 1911; *Bake-Rite Mfg. Co. v. Tomlinson, et al.*, 16 F. (2d) 556, C. C. A. 9, 1926; *Gilchrist Co. et al. v. Kar-Lac Co.*, 29 F. (2d) 153, C. C. A. 7, 1928.

and validity of its claims. Throughout the eight-year period after the grant of the original patent until the filing of the reissue, the original patent was subjected to scrutiny by people well acquainted with the patent law and by counsel of established reputation and of unquestionable competence and although they had every reason to be critical of the patent none of them ever suggested that the patent was defective or invalid because of any defect in the form of the original claims. During this eight-year period licenses to operate under the patent were taken out by the petitioner and by the R. L. Bart Laboratories of California (R. 192-3). Some few years later petitioner bought the patent outright (R. 255). Respondent's president Du Mont, a man skilled in patent matters, had previously arranged to acquire a license from Dr. Bedell. On the sale of the patent to petitioner, Du Mont was so anxious to obtain a license from the new owner, that he consulted counsel to see whether he could compel petitioner to grant him a license (R. 194). The license was willingly granted to him and Du Mont operated under this license and paid royalties for over a year until the end of 1935 (R. 12-13).

At the end of 1935, when the question of transferring the license to Du Mont's newly formed corporation arose, an opinion on validity was obtained by respondent from Bacon & Thomas of Washington, and from Darby & Darby of New York. These counsel suggested that certain prior art might anticipate Bedell but did not suggest that Bedell's invention was improperly claimed (R. 13-14; Exh. 2-A, R. 116-8; Exh. 2, R. 115). Respondent declined to accept a license and present counsel were consulted by petitioner first to renew negotiations and finally in January, 1937, to bring suit.

Present counsel, in its preparation of the case for trial, came to the conclusion that the form of claims 1 to 6 was such that it might render them invalid. On careful analysis, present counsel noticed that the third element of the claims, namely the coupling means, is not actually defined

in terms of the function which it performs in the combination but in terms of the function or result to be obtained by the combination as a whole. In this respect the claims are defective in form. It is a widely accepted rule, however, that claims should be construed in the light of the specification and limited to the means there described. In the light of this rule, the conclusion of counsel that claims 1 to 6 were defective in form did not necessarily lead to a conclusion that they were invalid since the specification of the patent disclosed very exactly the metes and bounds of the invention and the means actually invented by Bedell. In order however to avoid any possible question as to the validity of the claims, counsel advised petitioner to reissue the patent (R. 123). This was the first time in the eight years since the grant of the patent that the form of the claims had been criticized. This report was made on February 11, 1937, and reissue was applied for promptly thereafter on the stated ground that the claims might be construed to be functional and hence invalid (R. 59-61).

The reissue was granted on December 13, 1938. By the reissue, claims 1 to 6 of the original were cancelled and narrowed claims 6 to 13 allowed. Present claims 1 to 5 were carried over from the original patent either without change or with superficial alterations only. The specifications and drawings were corrected as to certain details but the propriety of these changes has not been challenged.

The District Court in a considered opinion (R. 127-38) found the invention to be one of real merit (R. 133), novel and patentable and that it had been admittedly appropriated by defendant with respect to the broad claims in suit. The issue of infringement with respect to certain of the more specific claims in suit was also resolved in petitioner's favor (R. 134-5). The District Court rejected the technical defenses relating to the propriety of the reissue, holding on the evidence that neither the present owner, petitioner, nor Professor Bedell, the patentee, was aware of the defect in the original patent until it was called to their atten-

tion by present counsel while preparing the instant case for trial; that the reissue was filed because of counsel's advice that claims of the original patent were in such form that they might be held invalid; that in filing the reissue plaintiff made no misrepresentation to the Patent Office; that on the contrary its representative attended before the Examiner in the Patent Office so that the Examiner had ample opportunity to satisfy himself as to when the plaintiff learned of the defect in certain claims of the patent and that under the evidence in the case there was no unreasonable delay in applying for the reissue (R. 136-7).

The Court of Appeals did not pass on the merit of the invention* but reversed the lower court solely on technical grounds going to the propriety of the reissue. The Court of Appeals held, as a matter of law, that the action of a solicitor in drafting claims of a patent in functional form could not constitute "inadvertence, accident or mistake" within the meaning of the reissue statute and accordingly held the reissue patent in suit invalid (R. 320-1).

Also, and without regard to the evidence or the findings of fact of the District Court, the Court of Appeals held that the reissue patent was invalid for unreasonable delay. This decision was based on the Court's conclusion that since the functional nature of the claims appeared on the face of the original patent, the invalidity of these claims was obvious as a matter of law and should have been apparent to anyone with even a rudimentary knowledge of patent law. Consequently the Court held that an obligation arose to correct the patent immediately on its issuance. The period intervening between the grant of the original patent and the reissue application being eight years, the Court held the reissue patent invalid for laches even though the purpose of the reissue was to narrow the claims (R. 321-4).

*As to the merits the Court merely said "The invention and its place in the art are fully described in the opinion of the district court . . ." (R. 316).

Petitioner filed a petition for rehearing which was denied in a supplemental opinion (R. 284, 312). Petitioner also filed a petition for reconsideration which was denied without opinion (R. 326, 332).

The Questions Presented

1. Can the action of a patent solicitor in drafting a claim which is functional in form when construed without reference to the specification constitute "inadvertence, accident, or mistake" within the meaning of the Reissue Statute?

2. Where a defect in a patent raises a question of validity which is wholly one of law on the face of the patent, can a patentee be charged with unreasonable delay in failing to disclaim or reissue before a court has passed on the validity of the patent?

3. Where a claim for a combination of elements is functional in form when construed without reference to the specification, is the claim necessarily invalid as a matter of law even though on reference to the specification there can be no doubt as to the identity of the combination which the claim seeks to define?

Reasons for Granting the Writ

1. The decision of the Court of Appeals that, as a matter of law, the action of a patent solicitor in drafting a claim which is functional in form when construed without reference to the specification does not constitute "inadvertence, accident, or mistake" within the meaning of the reissue statute is in conflict with decisions of this Court

and of the Circuit Courts of Appeals for the First, Second, Fourth, Sixth, Seventh and Ninth Circuits.

Topliff v. Topliff, 145 U. S. 156;

O'Reilly v. Morse, 15 How. 62;

Houghton v. Whitin Machine Works, 153 Fed. 740 (C. C. A. 1st); *Autopiano Co. v. American Player Action Co.*, 222 Fed. 276 (C. C. A. 2nd); *Crown Cork & Seal Co. v. Aluminum Stopper Co.*, 108 Fed. 845 (C. C. A. 4th); *Gross v. Norris*, 26 F. (2d) 898, affirming 18 F. (2d) 418 (C. C. A. 4th); *American Automotoneer Co. v. Porter*, 232 Fed. 456 (C. C. A. 6th); *Van Kannel Revolving Door Co. v. Winton Hotel Co.*, 276 Fed. 234 (C. C. A. 6th); *Moneyweight Scale Co. v. Toledo Computing Scale Co.*, 187 Fed. 826 (C. C. A. 7th); *Perfection Disappearing Bed Co. v. Murphy Wall Bed Co.*, 266 Fed. 698 (C. C. A. 9th).

2. The decision of the Court of Appeals that, where a defect in a patent raises a question of validity which is wholly one of law on the face of the patent, a patentee can be charged with unreasonable delay in failing to disclaim or reissue before a court has passed on the validity of a patent is in conflict with decisions of this Court.

O'Reilly v. Morse, 15 How. 62;

Seymour, et al. v. McCormick, 19 How. 96;

Gage v. Herring, 107 U. S. 640;

Yale Lock Mfg. Co. v. Sargent, 117 U. S. 536.

3. The decision of the Court of Appeals that a claim for a combination of elements, functional in form when construed without reference to the specification, is necessarily invalid as a matter of law even though on reference to the specification there can be no doubt as to the identity of the combination which the claim seeks to define, is in conflict with decisions of this Court and of the Courts of Appeals for the Second, Fourth, Sixth, Seventh and Ninth

Circuits and the Court of Appeals for the District of Columbia.

Under the conflicting decision of the Court of Appeals for the District of Columbia, the Patent Office is currently granting patents which are absolutely void under the present decision.

Seymour v. Osborne, 11 Wall. 516;
Mitchell v. Tilghman, 19 Wall. 287;
The Corn-Planter Patent, 23 Wall. 181;
Outlook Envelope Co. v. General, etc., Co., 239 Fed. 877 (C. C. A. 2nd); *Engineering and Research Corporation, et al. v. Horni Signal Corporation*, 98 F. (2d) 682 (C. C. A. 2nd); *Bisight Co. v. Onepiece Bifocal Lens Co.*, 259 Fed. 275 (C. C. A. 4th); *Demco v. Doughnut Mach. Corp.*, 62 F. (2d) 23 (C. C. A. 4th); *United Shoe Mach. Corp. v. H. Gordon Co.*, 59 F. (2d) 903 (C. C. A. 6th); *Ford Motor Co. v. Gordon, etc., Co.*, 87 F. (2d) 390 (C. C. A. 6th); *Arnold v. Tyden*, 193 Fed. 410 (C. C. A. 7th); *American Can Company v. Hickmott etc. Company*, 142 Fed. 141 (C. C. A. 9th); *Raytheon Mfg. Co. of Newton, Mass. v. Coe*, 96 F. (2d) 527 (App. D. C.).

Wherefore it is respectfully submitted that this petition for a writ of certiorari to the Circuit Court of Appeals for the Third Circuit should be granted.

DEAN S. EDMONDS,
 R. MORTON ADAMS,
 BALDWIN GUILD,
 GEORGE E. FAITHFULL,
 W. PETERS BLANC,
Counsel for Petitioner.

Dated: New York, N. Y., July 16, 1942.





BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

The opinion of the United States District Court for the District of Delaware appears at page 127 of the record and is reported in 38 F. Supp. 495. The opinions of the Circuit Court of Appeals for the Third Circuit appear at pages 315 and 312 of the record and are reported in 53 U. S. P. Q. 490 and 53 U. S. P. Q. 575.

Jurisdiction

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925, c. 229 (28 U. S. Code, Sec. 347). The decree of the Circuit Court of Appeals for the Third Circuit which petitioner seeks to have reviewed was entered May 12, 1942 (R. 311).

Statement of the Case

The essential facts of the case are stated in the accompanying petition for writ of certiorari.

Specification of Errors

The error which petitioner will urge if the writ of certiorari is issued is that the Circuit Court of Appeals for the Third Circuit erred in holding that the patent in suit was improperly reissued.

Summary of Argument

The points of argument will follow the reasons relied upon for allowance of the writ of certiorari.

ARGUMENT

I.

The decision of the Court of Appeals that, as a matter of law, the action of a patent solicitor in drafting a claim which is functional in form when construed without reference to the specification does not constitute "inadvertence, accident, or mistake" within the meaning of the Reissue Statute is in conflict with the decisions of this Court and of the Circuit Courts of Appeals for the First, Second, Fourth, Sixth, Seventh and Ninth Circuits.

The Reissue Statute, by its terms, authorizes the Commissioner of Patents to reissue a patent to correct errors which have arisen "*by inadvertence, accident or mistake, and without any fraudulent or deceptive intention*".

The requirement that the error of the original patent must have arisen by inadvertence, accident, or mistake has been in all the reissue statutes and was apparently adopted from this Court's decision in *Grant and others v. Raymond*, 6 Peters 218, which was handed down prior to the existence of any statute providing for reissuance of a patent and which led to the creation of the Reissue Statute.

In that case the Court used the words "inadvertence or mistake" and indicated that it used them as the antithesis of "fraud or misconduct on the part of the patentee" (p. 240) and that reissue is justified "if the mistake has been innocently committed by the inventor" (p. 242).

It has been determined by this Court that the requirement of the statute is not satisfied where the error sought to be corrected by reissue is an *error of judgment* on the part of the patentee or his solicitor. The expression "error of judgment" is used by the Court in a restricted legal sense to characterize a situation where deliberate election or choice dictates a course of action.

Thus, in *Miller v. Brass Co.*, 104 U. S. 350, this Court said with reference to the question of "inadvertence, accident or mistake" (p. 355):

"Now whilst, as before stated, we do not deny that a claim may be enlarged in a reissued patent, we are of opinion that this can only be done when an actual mistake has occurred; not from a mere error of judgment (for that may be rectified by appeal), but a real *bona fide* mistake, inadvertently committed; such as a Court of Chancery, in cases within its ordinary jurisdiction, would correct."

The situations in which "error of judgment" as distinguished from mistake has been adjudicated to exist by this Court fall into two classes. The first class includes errors which might have been rectified by appeal as where the claims sought by reissue were first proposed in the original application but rejected, and the rejection was acquiesced in although an appeal might have been taken from the rejection. *Leggett v. Avery*, 101 U. S. 256, 259; *Dobson v. Lees* and cases cited, 137 U. S. 258, 263-66.

The second situation which this Court has classified as "error of judgment" which does not warrant reissue is where the patentee chooses to disclose and claim in his original patent only a part of the invention to which he might otherwise have been entitled. The failure to include his full invention in the original patent constitutes "error of judgment" and not inadvertence, accident, or mistake. *Coon and Another v. Wilson*, 113 U. S. 268, 277-8; *Huber v. Nelson Mfg. Co.*, 148 U. S. 270, 287-290.

“Inadvertence, accident or mistake”, on the other hand, is ordinarily found where the solicitor fails to define properly or adequately in the claims the invention disclosed in the specification. This was the situation in *Topliff v. Topliff*, 145 U. S. 156, the leading case on the subject of reissues.

In that case the patent was for an improvement in connecting carriage-springs and the claim was changed by providing that the connecting-rods should be “secured directly to the hind axle and front bolster” instead of “to the front and rear axles” as provided in the claim of the original patent. The error was apparent on the face of the patent “since affixing the connecting-rod and springs to the front axle would render it impossible to be turned, and in addition to this, the original drawing shows it affixed to the bolster.” Although the invention was clearly described in the specification, the Court found the erroneous wording of the claim to be “a clear mistake” (p. 164), and after a general review of the earlier decisions of the Court on reissues, said (p. 171):

“The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. Under such circumstances, it would be manifestly unjust to deny him the benefit of a reissue to secure to him his actual invention, provided it is evident that there has been a mistake and he has been guilty of no want of reasonable diligence in discovering it, and no third

persons have in the meantime acquired the right to manufacture or sell what he had failed to claim. The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation."

The Court of Appeals in the present case did not accept this interpretation of the Reissue Statute in applying it to the facts of the instant case.

The Court of Appeals found that the wording of claims 1 to 6 of the original patent was erroneous in that the claims defined the function of Bedell's invention or the problem which is solved rather than the means by which he solved the problem. Then, basing its conclusion solely on the functional nature of the claims, the Court held that the erroneous wording of the claims must be considered, as a matter of law, to be the result of deliberate intention constituting an "error of judgment" and not an "inadvertence, accident, or mistake" within the statute.

In the words of the Court (R. 320):

"It is much more rational to conclude, as we do, that they drew the functional claims with the intention of covering any and all means which might be devised in the future to solve the problem which Bedell's particular means solved. *Since the law does not permit the making of a functional claim this action of Bedell's solicitors, if it can be considered an error, was clearly no more than an error of judgment.* But an error of judgment, even though made by the solicitor and not by the patentee himself, is binding upon the patentee and may not be rectified by a reissue patent." (Emphasis added.)

This conclusion of the Court was derived entirely from the face of the original patent. There was no extrinsic

evidence that the patentee or his solicitor harbored any fraudulent intention. While the Court permitted itself to surmise that the patent solicitor deliberately drew claims broader than the law permits,* its decision is plainly predicated on the proposition that the drafting of a claim functional in form constitutes *per se* an *error of judgment* and not "inadvertence, accident, or mistake" within the statute (opinion, R. 321). This conclusion is in direct conflict with the decision of this Court in *O'Reilly v. Morse*, 15 How. 62 in which the principles set forth in *Topliff v. Topliff* were applied to a situation of the same nature as that presented here.

In that case, the eighth claim of Professor Morse's patent for the telegraph was held invalid as being for the function or result of the invention rather than the means by which the function or result were effectuated. And though this invalid claim was in the patent for 13 years and its functional nature was apparent on the face of the patent the court did not hold the patent invalid but permitted the defective claim to be expunged. In that case it was to be cancelled by disclaimer. However, the disclaimer

*This surmise based on the Court's belief that the claims were obviously functional and invalid is opposed to the evidence and findings of the District Court. The District Court on uncontradicted evidence found that neither the plaintiff nor Professor Bedell, the patentee, knew that any claims of the original patent were invalid until shortly before the reissue was filed (R. 136) and the evidence further establishes that the functionality and invalidity of the claims was not in fact obvious to persons familiar with the patent law since the several persons who secured rights under the original patent and the several counsel retained by respondent to appraise the validity of the original patent never perceived any defect in the form of the original claim prior to the reissue (*supra* pp. 4-5).

This surmise also disregards the action of the Patent Office in approving the form of the claims as valid.

statute (R. S. 4917)* like the reissue statute, provides that the defect to be corrected must have arisen "through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention * * *". The plaintiff in that case attempted to avoid a holding that the patent was invalid by insisting that even though the claim was invalid there was no necessity to disclaim since the statute contemplated disclaimer only in case of mistakes of *fact*, whereas the drafting of a functional claim constituted a mistake of *law* and did not come within the statute. The Court rejected this argument and held that a mistake of law renders a patent wholly invalid under the disclaimer statute, and, what is of greater interest here, that a mistake of law is a mistake curable by disclaimer and comes equally, with mistakes of fact, within the meaning of the terms "inadvertence, accident, or mistake". Chief Justice Taney said (pp. 120-1):

"It has been urged, on the part of the complainants, that there is no necessity for a disclaimer in a case of this kind. That it is required in those cases only in which the party commits an error in fact, in claiming something which was known before, and of which he was not the first discoverer; that in this case he was the first to discover that the motive power of electro-magnetism might be used to write at a distance; and that his error, if any, was a mistake in law, in supposing his invention, as described in his specification, authorized this broad claim of exclusive privilege; and that the claim therefore may be regarded as a nullity, and allowed to stand in the patent without a disclaimer, and without affecting the validity of the patent."

"This distinction can hardly be maintained."

"* * * The words of the acts of Congress above quoted show that no patent can lawfully issue upon

*The full text of the disclaimer statute RS4917 will be found in the Appendix, page 32.

such a claim. For he claims what he has not described in the manner required by law. And a patent for such a claim is as strongly forbidden by the act of Congress, as if some other person had invented it before him."

"Why, therefore, should he be required and permitted to disclaim in the one case and not in the other? The evil is the same if he claims more than he has invented, although no other person has invented it before him."

* * * * *

"Whether, therefore, the patent is illegal in part because he claims more than he has sufficiently described, or more than he invented, he must in either case disclaim, in order to save the portion to which he is entitled; and he is allowed to do so when the error was committed by mistake."

The Court accordingly permitted Morse to disclaim the functional eighth claim and thus preserve the valid portions of that patent. No distinction can be drawn between the *Morse* case and the instant case on the ground that the disclaimer statute were there involved since the language of the two statutes is identical in this regard and their purpose is fundamentally the same.

The decision in the *Morse* case makes it clear that the drafting of a functional claim by a solicitor does not *per se* establish a deliberate or unlawful intention to claim that which the patentee had not in fact invented and that such action may constitute a mistake of law rectifiable by reissue and not an error of judgment. The case of *Dobson v. Lees*, 137 U. S. 258, relied on by the Court of Appeals in the instant case does not establish a different rule. In that case the patentee sought to add to his patent by reissue a claim that had been passed upon and rejected in the course of the original application. As this Court pointed out, "an interference was dissolved upon condition of the amendment, and the issue of the original letters was predicated

upon its abandonment" (137 U. S. 265). That case, and the Circuit Court decisions also relied on in the Court below, all present typical examples of errors of judgment as defined by this Court (*supra*, p. 13) and are in striking contrast to the present case.

It is true that the Court below stated that its decision was not to be understood as holding that in no case could a valid reissue patent be granted where the error of the original patent lay in the insertion of a functional claim. But it indicated that the only exception contemplated by it was the case of a mechanical error, as where a patent solicitor or his clerk unintentionally inserted a functional claim "in place of other claims" (R. 320-21). This qualification merely emphasizes the position of the Court of Appeals that any error arising by reason of the action of the patent solicitor in drafting the claims constitutes an "error of judgment" and not "inadvertence, accident or mistake" even though the solicitor's action occurred in consequence of a mistaken understanding of the law, or an innocent misapplication of the law to the facts before him. This interpretation of the statute is in direct conflict with the interpretation applied in the decisions of this Court cited above.

Conflict with Other Courts of Appeals

The interpretation of the statute adopted by this Court has been followed by the Circuit Courts of Appeals for the First, Second, Fourth, Sixth, Seventh and Ninth Circuits. Thus, it is broadly stated by the Court of Appeals for the Sixth Circuit in *Van Kannel Revolving Door Co. v. Winton Hotel Co.*, 276 Fed. 234, 238:

"The substantial basis of the application for reissue was that the claims were not commensurate with the invention. If Van Kannel, through his solicitor, without intending to do so, drafted or accepted claims not

commensurate with the invention, such act is an 'inadvertence' within the meaning of Rev. Stat. § 4916 (Comp. St. § 9461), which entitled him to a reissue."

The rule has been applied in cases where the mistake was one of fact. In *Autopiano Co. v. American Player Action Co.*, 222 Fed. 276, the patentee, under a misconception as to the scope of the prior art, reissued his patent to omit certain claims appearing in the original patent. Thereafter, learning that the prior art was not so broad as he supposed, he obtained a second reissue in which the original claims were reasserted. The Court of Appeals for the Second Circuit said (p. 281):

"The first reissue was certainly not obtained by 'inadvertence'. It was the result of the deliberate attempt of a patent solicitor to modify an existing patent; but it was, so far as we can see, none the less a mistake, and not merely a mistake of judgment, as when applicant's solicitor submits to rejections by the Patent Office. The mistake was as to what the prior art contained. * * * When this misconception as to the condition of the prior art was discovered, application was promptly made for a second reissue, and the affidavit on which such application was based truthfully stated—at least, there is nothing shown to negative its truthfulness—that the omission from the first reissue of the original claims was a 'mistake'. That there was 'any fraudulent or deceptive intention' we find no evidence at all".

The same rule has been applied in cases where the mistake was one of law. In *Gross v. Norris*, 26 F. (2d) 898, the Circuit Court of Appeals for the Fourth Circuit affirmed the decision of the District Judge and adopted his opinion with regard to this question as it is set forth at 18 F. (2d) 418, 422:

"But a mistake which will justify a reissue need not necessarily be a mistake of fact. The Supreme Court in *Topliff v. Topliff*, *supra*, comments upon the difficulty in the preparation of the specification and claims of a patent, and indicates that the failure of an inventor to describe his invention with requisite certainty, or to express a claim so as fully to cover an invention, will furnish ground for the reissue if seasonably applied for".

For other cases to the same effect see: *Crown Cork & Seal Co. v. Aluminum Stopper Co.*, 108 Fed. 845, 852-3, C. C. A. 4; *Houghton v. Whitin Machine Works*, 153 Fed. 740, 746, C. C. A. 1; *Moneyweight Scale Co. v. Toledo Computing Scale Co.*, 187 Fed. 826, 829-31, C. C. A. 7; *American Automotoneer Co. v. Porter*, 232 Fed. 456, 460, C. C. A. 6; *Perfection Disappearing Bed Co. v. Murphy Wall Bed Co.*, 266 Fed. 698, 699-700, C. C. A. 9.

The foregoing decisions of this Court and of the Courts of Appeals of other Circuits are in direct conflict with the decision of the Court of Appeals for the Third Circuit. Grant of a writ of certiorari is requested to settle this conflict.

II.

The decision of the Court of Appeals that, where a defect in a patent raises a question of validity which is wholly one of law on the face of the patent, a patentee can be charged with unreasonable delay in failing to disclaim or reissue before a court has passed on the validity of a patent is in conflict with the decisions of this Court.

Whether original claims 1-6 are broader than the patent law permits, is a question of law to be determined on the face of the patent. No question of fact is involved. The Court below specifically held that the specification of the original patent "disclosed clearly and in detail the vari-

ous aspects and embodiments of Bedell's invention and the metes and bounds thereof" (R. 320). So that in granting the patent the Patent Office had before it all the facts to determine whether as a matter of law claims 1-6 were valid. The granting of the patent necessarily involved a finding by the Patent Office that claims 1-6 were proper in form and valid in law.

It has been repeatedly held by this Court that, as in the case of any public official acting within the scope of his official duty, the decision of the Commissioner in granting a patent is presumed to be correct. *Philadelphia and Trenton Ry. Co. v. Stimpson*, 14 Peters 448, 458-9; *Agawam Co. v. Jordan*, 7 Wall. 583, 597; *Mitchell v. Tilghman*, 19 Wall. 287, 390; *Tilghman v. Proctor*, 102 U. S. 707, 735; *Westinghouse etc. Co. v. Formica etc. Co.*, 266 U. S. 342, 348.

While the Commissioner's decision is subject to reexamination by the courts, the granting of the patent raises a presumption of validity on which the patentee is entitled to rely until that presumption has been overthrown by new evidence or by a decision of a court overruling the Commissioner's decision. On several occasions this Court has applied this rule to cases of the present type where the question of validity is one of law on the face of the patent and has held that under such circumstances the patentee is entitled to rely on the presumption of validity attending the grant of the patent and need not disclaim* until the validity of his patent has been passed on by a court.

In *Gage v. Herring*, 107 U. S. 640, suit was brought on a reissued patent granted January 16, 1872 and extended for a term of seven years from April 20, 1872, the date on which the original patent would have expired (p. 640).

*In the instant case the patentee elected to cure the possible defect in his patent by reissue rather than by disclaimer. But the same requirement of diligence is exacted in both cases.

The reissue repeated the claim of the original patent and added a new and enlarged claim (p. 644). The Court held the new claim invalid but stated that plaintiffs, upon filing a disclaimer of the new claim, might recover on the old claim. This decision was rendered in 1882, at least ten years after issuance of the reissue patent containing the new invalid claim. On the question of diligence Justice Gray said (p. 646):

“Considering that the question of the validity of the new claim in the reissue is a question of law upon the face of the patent, and that its validity has been sanctioned by the Commissioner of Patents in granting the reissue, and upheld by the Circuit Court, there has been no unreasonable delay in entering a disclaimer; for the plaintiffs were not bound to disclaim until after a judgment of this court upon the question. *O'Reilly v. Morse*, above cited; *Seymour v. McCormick*, 19 How. 96.”

In *Seymour et al. v. McCormick*, 19 How. 96, the Court as a matter of law gave a claim of McCormick's patent for improvements in reaping machines a construction that rendered it invalid. Since the patent had issued in 1845 and this decision was rendered in 1856, the defendant insisted that the delay of eleven years was excessive and that consequently no disclaimer of the invalid claim could be entered and the entire patent should be held void. The Court rejected this contention, saying (p. 106):

“In respect to the question of unreasonable delay in making the disclaimer, as going to the whole cause of action, the court are of opinion that the granting of the patent for this improvement, together with the opinion of the court below maintaining its validity, repel any inference of unreasonable delay in correcting the claim; and that, under the circumstances, the question is one of law. This was decided in the case of the Telegraph (15 How. 121)”.

See also to the same effect *O'Reilly v. Morse* (the Telegraph case), 15 How. 62, 121; *Yale Lock Mfg. Co. v. Sargent*, 117 U. S. 536, 554; *Burdett v. Estey*, 4 Fed. Cas. pages 712, 718 (Case No. 2145).

The decision of the Court of Appeals holding the re-issue invalid for unreasonable delay in its filing, was predicated on its view that an obligation to correct the original patent arose immediately on its issuance (R. 322-3). This view of plaintiff's obligation is in direct conflict with the decisions of this Court above cited which hold that where the question of validity is a question of law on the face of the patent, the patentee is not bound to correct the original patent until after a decision by a court on the question because he is entitled to rely on the presumption of validity attending the grant of the patent.

The Court of Appeals' error arose from its misapplication of the case of *Miller v. Brass Co.*, 104 U. S. 350 (R. 322). In that case the original patent was reissued 16 years after the grant of the original patent, not to correct an error of law occurring in the patent, but to obtain claims of admittedly broadened scope. The Court found that the inadequacy of the original claims to cover fully the invention was immediately apparent upon an inspection of the patent and that therefore a correction if desired should have been applied for immediately.

This decision is not in conflict with the cases cited above nor has it application to the instant case. It is not the duty of the Patent Office to see that an applicant obtains claims which cover his invention in its broadest aspects as it is its duty to see that such claims as are presented are proper. Whether or not the patentee has claimed his entire invention is a matter of fact peculiarly within his knowledge, and one which is addressed directly to his interest. No presumption that the claims are adequate to protect the invention attends the grant of the patent, and hence it is reasonable to exact from the patentee the greatest diligence in scrutinizing the award to

make sure that he has obtained his full due. The legality of the grant, on the other hand, is the particular interest of the Patent Office, and issuance of the patent raises the presumption that every legal requisite has been complied with. The patentee consequently has the right to rely upon the validity of claims so sanctioned until notified of the error by the judgment of a court having jurisdiction to review the decision of the Patent Office.

In this case plaintiff did not wait until after decision to correct any deficiency of the patent although it might have done so under the decisions of this Court. Plaintiff authorized the filing of the reissue when the possible invalidity of claims 1-6 was first called to its attention by counsel while preparing for the present case.

Thus plaintiff's conduct more than measures up to the standard of diligence established by the Supreme Court.

The decisions above cited of this Court are in direct conflict with the decision of the Court of Appeals in this case. Grant of a writ of certiorari is requested to settle this conflict.

III.

The decision of the Court of Appeals that a claim for a combination of elements, functional in form when construed without reference to the specification, is necessarily invalid as a matter of law even though on reference to the specification there can be no doubt as to the identity of the combination which the claim seeks to define, is in conflict with decisions of this Court and of the Courts of Appeals for the Second, Fourth, Sixth, Seventh and Ninth Circuits and the Court of Appeals for the District of Columbia.

As we have already pointed out, the decision of the Court of Appeals holding the reissue invalid for unreasonable delay was predicated upon its view that an obligation to correct the original patent arose immediately on its issuance.

This view was based on the Court's conception that by reason of the functional nature of the claims the invalidity of the patent was obvious and should have been clear to anyone with even a rudimentary knowledge of patent law (R. 322-3).

In addition to the fact that the Court's ruling disregards the presumption of validity attending the issuance of a patent, the Court's conception that the defective form of the claims rendered them "*obviously invalid*" is in conflict with the decisions of this Court.

It is the general rule that the claim of a patent "must always be explained by and read in connection with the specification" (*Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 432). This rule has been given special application in the case of patent claims defective in that when literally construed they define the function or result of the invention instead of the means.

In the early case of *Seymour v. Osborne*, 11 Wall. 516, a claim to an improvement in reaping machinery was attacked on the ground that the claim, when literally construed, was for an effect and not for any particular machinery. The Court held the claim valid, nevertheless, saying (p. 547):

"Where the claims immediately follows the description of the invention it may be construed in connection with the explanations contained in the specifications, and where it contains words referring back to the specifications, it cannot properly be construed in any other way."

In that case the claim contained the words "substantially as described" which referred back to the specification much as does the expression "In a device of the type described—" contained in the claims of the present case.

In *Mitchell v. Tilghman*, 19 Wall. 287, a decision handed down three years later, this Court held that the presence of such words was not even necessary but that they would

be implied in cases where otherwise the claims might be construed as functional. In that case the patent was for a process. In sustaining the claim the Court said (pp. 391-2, 395):

“Usually the claim contains the words as described or substantially as described, or words of like import, which are everywhere understood as referring back to the descriptive parts of the specification. Words of such import, if not expressed in the claim, must be implied, else the patent in many cases would be invalid as covering a mere function, principle, or result, which is obviously forbidden by the patent law, as it would close the door to all subsequent improvements.”

* * *

“Limited, as explained by reference back to the descriptive parts of the specification, the claim may well be regarded as in due form, but it is quite clear that it would be invalid if it is not so limited, as it has always been held that a patent embraces nothing more than the improvement described and claimed as new, and that anyone who afterwards discovers a method of accomplishing the same object, substantially and essentially differing from the one described, has a right to use it and to vend it to others to be used.”

“Apply that rule and it is clear that the invention must be limited to the described method of producing free fat-acids and solution of glycerine from the fatty and oily substances therein mentioned, * * *”

* * *

“Construed and defined as explained, the first issue respecting the patent must be found for the complainant, * * *”.

See to the same effect *The Corn-Planter Patent*, 23 Wall. 181, 225-6.

The same rule has been asserted by the Circuit Courts of Appeals. In a recent decision, *Engineering and Re-*

search Corporation et al. v. Horni Signal Corporation, 98 F. (2d) 682, the Court of Appeals for the Second Circuit stated the rule as follows (p. 684):

“The claims are so general and functional that ver-
bally there can be no reasonable doubt that the defend-
ant infringed them; indeed it scarcely disputes that it
does; it says that they are invalid. The fact that they
are functional need not be conclusive against them;
most claims are so, more or less. *Davis Sewing Ma-
chine Co. v. New Departure Mfg. Co.*, 6 Cir., 217 Fed.
775, 782, 783; *Buono v. Yankee Maid Dress Corp.*,
2 Cir., 77 F. (2d) 274, 277. But when a patentee draws
his claims in that form, he must be content that they
shall be limited at least by such details of the dis-
closure as are necessary to save the patent.”

See also *American Can Company v. Hickmott etc. Com-
pany* (C. C. A. 9), 142 Fed. 141, 146-7; *Arnold v. Tyden*
(C. C. A. 7), 193 Fed. 410, 412; *Outlook Envelope Co. v.*
General etc. Co. (C. C. A. 2), 239 Fed. 877, 878-9; *Bisight*
Co. v. Onepiece Bifocal Lens Co. (C. C. A. 4), 259 Fed.
275, 276; *United Shoe Mach. Corp. v. H. Gordon Co.* (C. C.
A. 6), 59 F. (2d) 903, 904-5; *Demco v. Doughnut Mach.*
Corp. (C. C. A. 4), 62 F. (2d) 23, 25; *Ford Motor Co. v.*
Gordon etc. Co. (C. C. A. 6), 87 F. (2d) 390, 391-2.

In addition to the foregoing circuit court decisions, the
Court of Appeals for the District of Columbia has re-
cently reasserted this rule with reference to a claim strik-
ingly similar to the claims involved here, *Raytheon Mfg.*
Co. of Newton, Mass. v. Coe, 96 F. (2d) 527, 529. Under
this decision the Patent Office is currently granting pat-
ents which are absolutely void under the decision of the
Court of Appeals in the present case.

The Court below relied on *Holland Furniture Co. v. Per-
kins Glue Co.*, 277 U. S. 245 and *General Electric Co. v.*
Wabash Co., 304 U. S. 364 in support of its position. Those
cases do not support the Court's position but on the con-

trary are in accord with the general rule above stated. In both cases this Court sought to supplement the defect of the claims by reference to the descriptive portions of the patent. In the *Holland* case this Court pointed out that the defendant's product did not infringe when the claims were interpreted in the light of the specification. The decree sustaining the bill was reversed, not because the claims of the patent were absolutely void, but because they were invalid if construed literally, and not infringed if construed in the light of the description (277 U. S. 245, 255 and 258). In the *Wabash* case this Court likewise recognized the general rule and sought to sustain the claims by construction. The vice of the patent that led to this Court's holding of invalidity was that the specification, not merely the claim, described the product in functional terms (304 U. S. 364, 373). No such circumstances exist here and the Court of Appeals found as fact (R. 320):

"The specification of the original patent clearly discloses Bedell's concept and the means he employed to solve his problem."

At most, under these decisions the functional form of claims 1-6 brought their validity within the field of debate or of speculation, and this was the ground asserted in the reissue oath (R. 122).

Reissue was proper under such circumstances. Contrary to the lower Court's belief (R. 313-14), absolute invalidity is not a condition precedent of reissue. Reissue is available to remove a doubt as to the validity of a claim and reissued patents have been frequently sustained even when it was subsequently found that the claims would have been valid had their original form been retained (*Hobbs v. Beach*, 180 U. S. 383, 394; *Abercrombie & Fitch Co. v. Baldwin*, 245 U. S. 198, 207; *Traitel Marble Co. v. U. T. Hungerford, etc. Co.* (C. C. A. 2), 18 F. (2d) 66, 69; *Kraft Cheese Co. v. Pabst Corp.*, 17 F. (2d) 787, 791). The same

rule applies to disclaimers (*Carnegie v. Cambria*, 185 U. S. 403, 435-6; *Triplett v. Lowell*, 297 U. S. 638, 640; *United Chromium Co. v. International Silver Co.* (C. C. A. 2), 60 F. (2d) 913, 914-5).

Conclusion

In view of the conflict of decisions above set forth it is urged that the petition for writ of certiorari be granted.

Respectfully submitted,

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Counsel for Petitioner.

Dated: New York, N. Y., July 16, 1942.





APPENDIX**Reissue Statute**

R. S. SEC. 4916. (U. S. C., title 35, sec. 64.) Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in the case of a machine

Appendix

patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

Disclaimer Statute

R. S. SEC. 4917. (U. S. C., title 35, sec. 65.) Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

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IN THE
Supreme Court of the United States
October Term, 1942
No. 243

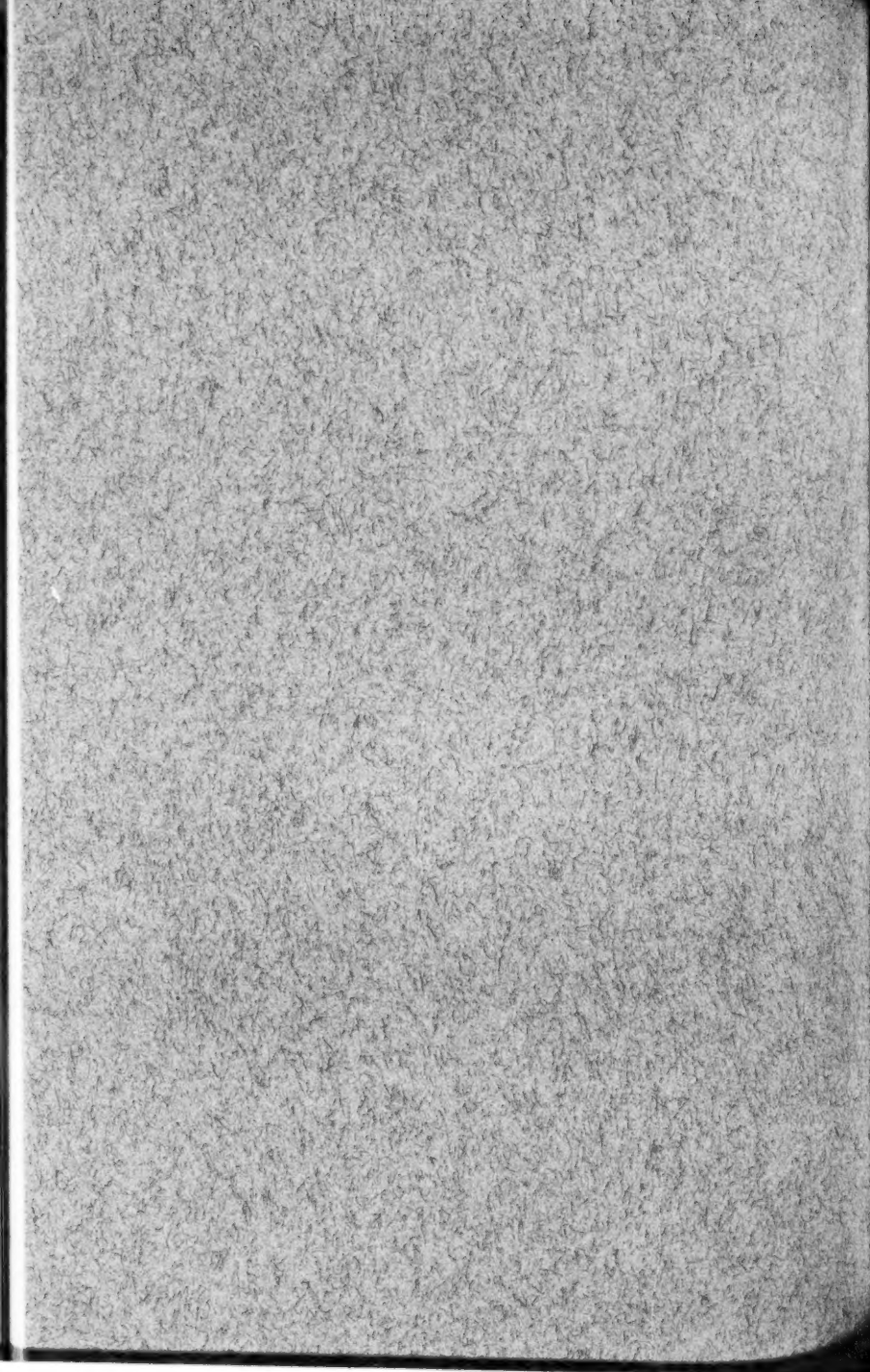
GENERAL RADIO COMPANY,
Petitioner,
vs.

ALLEN B. DU MONT LABORATORIES, INC.,
Respondent.

MEMORANDUM FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

SAMUEL E. DABBY, JR.,
Counsel for Respondent.

FLOYD H. CREWS,
Of Counsel.



IN THE
Supreme Court of the United States

October Term, 1942

No. 243

GENERAL RADIO COMPANY,

Petitioner,

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ALLEN B. DU MONT LABORATORIES, INC.,

Respondent.

MEMORANDUM FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

This is a patent infringement suit involving the ordinary issues of validity and infringement.

The reissue patent involved was held to be invalid by the Third Circuit Court of Appeals below. There has been no other adjudication of the patent by any other Circuit Court of Appeals. Therefore, there is no diversity of opinion between Circuit Courts of Appeals. Accordingly, the petition should be denied (*Keller v. Adams Campbell Co.*, 264 U. S. 314, 319; *Layne and Bowler Corp. v. Western Well Works*, 261 U. S. 387-393; *General Talking Pictures Corp. v. Western Electric Co.*, 304 U. S. 175, 178-179).

The reissue patent in this case is an outstanding example of a most flagrant abuse of the reissue statute. The original patent (No. 1,707,594) issued on April 2, 1929. Application

for reissuance thereof was not filed until August 18, 1937—*nearly nine years later.*

The ground alleged for the reissue in the patentee's oath was:

“(b) by reason of the patentee having claimed as his own invention or discovery, more than he had a right to claim as new, by including claims 1, 2, 3, 4, 5 and 6 of said original application and patent, which are in such terms that they may be construed to cover merely the function instead of the apparatus” (R. 122; see, also, opinion of the Court of Appeals, R. 319).

Obviously, as held by the Court of Appeals, this was not an “inadvertence, accident, or mistake” prescribed by the reissue statute as a condition to the grant of a valid reissue patent. To the contrary, it was the deliberate, considered action of skillful, competent attorneys. It is likewise as obvious, and was also pointed out by the Court of Appeals, that this alleged defect of the original patent *was apparent upon the face of the patent on the date of its grant on April 2, 1929*, and no excuse had been or could be offered for a delay of nearly nine years in discovering and correcting it.

In view of these circumstances, the petition unpardonably misconceives the issues decided by the Court of Appeals below in the futile effort to create a non-existent conflict with decisions of this Court and other Circuit Courts of Appeals. A mere reading of the two opinions (original opinion, R. 315, and on petition for rehearing R. 312) shows that factually they are based upon elementary principles announced years ago in decisions by this Court, and in no respect is there conflict between them.

Consequently, in the absence of diversity of opinion, this case is devoid of subject matter, novelty or grounds which would warrant review by this Court.

Respectfully submitted,

SAMUEL E. DARBY, JR.,
Counsel for Respondent.

FLOYD H. CREWS,
Of Counsel.

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FILED

SEP 19 1942

CHARLES EDMOND SEPTOR
CLERK

IN THE
Supreme Court of the United States
OCTOBER TERM, 1942.

No. 243.

GENERAL RADIO COMPANY,
Petitioner,

vs.

ALLEN B. DuMONT LABORATORIES, INC.,
Respondent.

**COMMENT ON RESPONDENT'S MEMORANDUM
IN OPPOSITION TO PETITION FOR
WRIT OF CERTIORARI**

DEAN S. EDMONDS,
R. MORTON ADAMS,
BALDWIN GUILD,
GEORGE E. FAITHFULL,
W. PETERS BLANC,
Counsel for Petitioner.



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The issuance of a writ of certiorari is invoked on the ground that the decision of the Court of Appeals in this case interpreting the reissue statute is in conflict with decisions of this Court and of the lower courts.

Respondent's counsel denies the existence of such conflict but does not support his denial and is unable to show that the conflict forming the basis of our petition does not exist.

Counsel does assert that the decision of the Court of Appeals is based "upon elementary principles announced years ago in decisions by this Court" (Memo. p. 2). But in our brief in support of the petition we pointed out that the Court of Appeals misapplied the elementary principles announced in *Dobson v. Lees*, 137 U. S. 258, and *Miller v. Brass Co.*, 104 U. S. 350 (Brief pp. 18, 24) and thus came into conflict with the decisions of this Court listed in the petition (pp. 8-10). Counsel offers no rebuttal.

Counsel refers to the action of the solicitor in drafting the original broad claims as "the deliberate, considered action of skillful, competent attorneys" (Memo. p. 2). Of course the action of a solicitor in drafting claims, in the absence of an accidental displacement of papers or a clerical error, is necessarily deliberate in the sense that it is a willful act. But it cannot be assumed as a matter of law that such an action is deliberate in the sense that it implies a consciousness of its ultimate consequences, and as this Court has held, where a solicitor, in seeking to draft claims as broadly as the law permits, submits claims improper in form either in consequence of a mistaken understanding of the law or by reason of an innocent misapplication of the law to the facts before him, this action, though willful, nevertheless constitutes a "mistake" within the meaning of the reissue statute.* (Petition pp. 12-21.) The Court of Appeals decision is in direct conflict.

Counsel also says that the defect corrected in the reissue was apparent on the face of the original patent. We agree in the sense that the functionality of claims 1 to 6 of the original patent and the effect of such functionality on the validity of these claims is a question of law to be determined from the face of the patent. But the action of the patent office in approving the form and legality of the claims precludes any conclusion, as a matter of law, that the invalidity of the claims is apparent in the sense of requiring immediate correction by the patentee before the action of the patent office has been reviewed by the Courts. This is the holding of this Court in the decisions referred to in support of our second point (Brief pp. 21-24) and

*This situation is in contrast to that presented where the solicitor has deliberately submitted claims which he knows to be improper in the effort to overreach the Patent Office. But there is no evidence of any bad faith on the part of the solicitor here and the evidence in the case is all to the contrary (Petition pp. 4-6).

the Court of Appeals decision is in direct conflict. Nor is the invalidity of the claims apparent as a matter of law even though the questionable form of the claims appears on the face of the patent* (See our Point 3, Brief pp. 25-30).

Counsel characterizes the reissue as "an outstanding example of a most flagrant abuse of the reissue statute" (Memo. p. 1). Actually, as we have pointed out in our brief in support of the petition, the appropriateness of reissue, in a situation such as the present one, has received the full sanction of this Court and also of the lower courts in repeated decisions.

There are no special equities in the present case to call for a departure from the settled rule and counsel suggests none.

The decision of the Court of Appeals was reached by placing an interpretation on the reissue statute in conflict with that accorded it by this Court and the lower courts. It is to determine this conflict on an important point of patent law that a writ of certiorari is asked.

Respectfully submitted,

DEAN S. EDMONDS,
R. MORTON ADAMS,
BALDWIN GUILD,
GEORGE E. FAITHFULL,
W. PETERS BLANC,
Counsel for Petitioner.

Dated: New York, N. Y.,
September 18, 1942.

*As a matter of fact the defect in the form of the claims was sufficiently subtle as to pass unnoticed even by present counsel for respondent until after the filing of the reissue. The history of the original patent is set forth in our Petition pages 4-6.